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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,915	01/17/2001	Yasuo Tano	4084-2163	5564

21888 7590 04/19/2005

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ST LOUIS, MO 63101

EXAMINER
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BUI, VY Q

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/761,915  
Filing Date: January 17, 2001  
Appellant(s): TANO ET AL.

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\_\_\_\_\_  
Joseph M. Rolnicki  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/28/2005.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1, 3, 4, 7, 9-15, 21-27 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

**5,118,291**

**Varaine**

**June- 1992**

**(10) Grounds of Rejection**

Claims 26 is rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on 7/19/2004.

Claims 1, 3-4, 7, 9-15 and 21-27 are rejected under 35 U.S.C. 251. This rejection is set forth in a prior Office Action, mailed on 7/19/2004.

**(11) Response to Argument**

As to the rejection of claim 26 under 35 U.S.C. 102(b), the Applicant argued that Varaine-'291 device and the device of the present invention have different intended uses and Varaine-'291 device does not have fine grains on the tip (Remarks filed 1/28/2005, page 9, lines 9-11).

However, Varaine-'291 (Fig. 1-6; abstract, lines 10-17; claim 1, col. 4-col. 5) discloses an instrument structured as recited in the claim, especially fine grains/micrograins located on a tip of the Varaine-'291 device. The language in claim 26 has failed to point out any structural difference between the present invention device and Varaine-'291 device. Further, in a device claim, the difference in the intended uses of the Varaine-'291 device and the device of the present invention cannot be given much patentable weight when there is no structural difference

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between the claimed invention and Varaine-'291 device. Therefore the present claimed invention should be rejected over Varaine-'291 device as set forth in the previous final "Office Action".

As to the rejection of claims 1, 3-4, 7, 9-15 and 21-27 under 35 U.S.C. 251, the Applicant admitted that the independent claim 1 of the parent case 09/058,183 was amended to include "a hollow tapered tip" and "said grains are located in a range of 0.5mm to 3.0mm from an end portion of said front tip" after a rejection applied over reference U.S. Patent Shimizu-3,809,101, but argued that **there is no (emphasis added) mention** of the specific 0.5mm to 3.0mm range in the prosecution history that the specific range 0.5mm to 3.0mm was added to claim 1 to distinguish the subject matter claimed from Shimizu-'101 (please see section (8) Argument of the "Appeal Brief" filed 1/28/2005).

However, in paper 6/a received on February 05, 1999 by U.S. PTO in the prosecution history of the parent case 09/058,183 (please see attachment with this "Examiner Answer" for reference), the "Amendment" and especially "Remarks" sections, line 13, page 5 to line 4 page 6, the Applicant argued that:

"Considering first then the rejection of Claim 1 and 4 under 35 U.S.C; §102 as being anticipated by Shimizu, it is noted that Claim <sup>1</sup>~~1~~ has been properly amended so as to be more closely directed to a membrane eraser used for ophthalmic surgery. More particularly, the membrane eraser is claimed as including an elastic body having a **hollowed tapered front tip in combination with a plurality of hard inorganic fine-grains fixed on a tapered front tip of the elastic member where the grains are located in a range of 0.5 mm to 3.0 mm from a tip-end portion of the front tip**. This is clearly distinguished from the nail file filing an individual's nails as shown in Shimizu which neither comprises a hollow tapered front tip of an elastic body nor does the same teach **limiting the location of the grains to the range presently claimed** and

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instead teaches only the utilization of an abrasive sheet 9 which extends substantially the entire length of the holding member of two connecting portions 6, as best illustrated in each of Figures 2B and 3B thereof. In view of the foregoing, it is respectfully submitted that Claim 1 clearly patently defines over the Shimizu and that Claim 4, based both upon the limitations set forth therein and based upon the dependency of Claim 4 from Claim I, also merits indication of allowability.”

After review the above argument, the Examiner found no motivation to modify Shimizu nail file to have grains in the above range as amended in claim 1 and the above argument provided good reasons to allow the case, therefore, claim 1 of parent case was allowed and the application was issued as U.S. Pat. 5,921,998.

It has been clear to the Examiner that the Applicant have relied on both features “hollow tapered front tip” and “grains are located in a range of 0.5mm to 3.0mm from an end portion of said front tip” presented in amended claim 1 of parent case 09/058,183 to distinguish the present invention over Shimizu reference.

Therefore, an exclusion of these two features from any independent claim in the present reissue application is considered as an attempt to recapture the two features, which have been surrendered during prosecution of the parent case 09/058,183.

For the above reasons, it is believed that the rejections should be sustained.



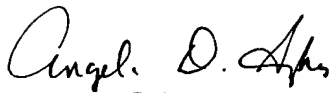
Respectfully submitted,

Vy Q. Bui  
Primary Examiner  
Art Unit 3731

Attachment: paper 6a, final Amendment and Remarks of claim 1 of parent case 09/058,183

April 6, 2005

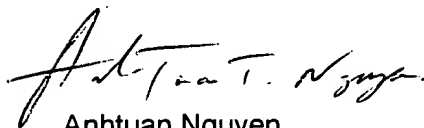
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